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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,845	01/21/2004	Robert Peterson	200202.402	5860
31740	7590	03/10/2005	EXAMINER	
THOMAS E. LOOP BARNARD, LOOP & MCCORMACK 947 POWELL AVENUE SW SUITE 105 RENTON, WA 98055			HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

8N

Office Action Summary	Application No. 10/762,845	Applicant(s) PETERSON, ROBERT	
	Examiner Alvin A. Hunter	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant is reminded of candor of good faith and duty to disclose all relevant material to the instant invention.

Specification

✓ The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Applicant does not disclose what type of Shore hardness is relied upon for measuring the hardness. ^{in claim 7}

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the golf ball being "from a composition that comprises ...". And claims 12-15 further recite additional material combined to the golf ball. How can the composition further comprise? The language implies a "consisting essentially of" transitional use in claim 1. What is the applicant trying to convey?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 7, 8, 12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Dillon, Jr. (USPN 3069170).

Regarding claims 1 and 3-5, Dillon, Jr. discloses a unitary molded golf ball being foamed from a composition that comprises a thermoplastic elastomer and a blowing agent (See Entire Document). It is submitted that the ethylene-vinyl acetate copolymer is not necessary in order to produce the invention being that the copolymer may be present in 0% by weight. Dillon, Jr. inherently discloses the thermoplastic elastomer in an amount of up to 99% in weight being that the composition would require a particular amount greater than 1% by weight of blowing agent in order to produce the foamed article.

Regarding claim 7, Dillon, Jr. inherently discloses the thermoplastic elastomer having a Shore hardness of 40 to 90.

Regarding claim 8, Dillon, Jr. discloses the thermoplastic elastomer being an ethylene- α -olefin copolymer thermoplastic elastomer.

Regarding claim 12, the composition comprises polypropylene.

Regarding claim 14, the composition comprises polyethylene.

Claims 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Puckett et al. (USPN 4839116).

Regarding claims 16, 18 and 20, Puckett et al. discloses a method of making a unitary molded golf ball comprising compounding the polymeric composition comprising a thermoplastic elastomer, combining the blowing agent with the polymeric composition,

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injecting the feedstock into a mold having a substantially spherical shape and cooling the mold to form the golf ball. Puckett et al. anticipates because claim 18 does not require the ethylene-vinyl acetate copolymer to be present.

Regarding claim 17, Puckett et al. discloses the golf ball being quenched in cool water, which would be agitated from placing the heated mold article therein.

Regarding claim 19, Puckett et al. inherently discloses the thermoplastic elastomer being 0 to 99% in weight because of the addition of the blowing agent and the fillers added thereto.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon, Jr. (USPN 3069170) in view of Park et al. (USPN 4101467).

Regarding claim 20, Dillon discloses a foamed golf ball comprising a thermoplastic elastomer and a blowing agent (See entire document). Dillon also suggests that ethylene copolymers may be combined with the composition. Park et al. discloses an ethylene-vinyl acetate copolymer being foamed with a blowing agent wherein reduced density and stiffness is obtained (See Abstract). One having ordinary skill in the art would have found it obvious to incorporate an ethylene-vinyl acetate copolymer as taught by Park et al., in order to reduce the stiffness and density of the

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golf ball. Method of making will not be giving any weight being that claim 20 is product by process. So long as the final product is obtained the process of making is not patentable.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1 and 9 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 21 and 22 of copending Application No. 10/785459.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 and 8-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6726577. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6726577 claims the same subject matter except requiring the entire golf ball being made of the composition. Though the above is not claimed in the present invention, U.S. Patent No. 6726577 anticipates the above claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 571-272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

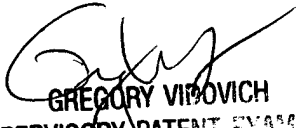
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

Alvin A. Hunter, Jr.


GREGORY VIROVICH
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